

Application No. 10/562,489
Amdt. dated 23 April 2009
Reply to Office Action of 22 November 2009

REMARKS / ARGUMENTS

In the above-identified Office Action the Examiner has objected to claims 21-22 because it claims a processor dependent on a method claim. Applicant has amended claims 21 and 22 so that they now are correct dependent claims. Claim 23 has been objected to because it claims a use of a processor. This claim has been canceled and, accordingly, the matter is considered obviated.

Claims 13, 15, 18 and 19 have been rejected as being indefinite for use of the word "preferably." Applicant has deleted that term and further dependent claims were added to retain coverage. As a result, this matter is considered obviated.

Claims 13-18 have been rejected as being unpatentable over the European patent to Visinoni et al. in view of the U.S. patent publication to Fanta et al. The Examiner has stated that it would have been obvious to substitute supercritical carbon dioxide as taught by Fanta et al. for the clearing agents in the method of Visinoni et al. The Examiner has stated that Visinoni et al. and Fanta et al. are analogous because both references are concerned with removing ethanol from a solid sample. However, as stated by the Federal Circuit in *In re Clay* 966 F.2d at 659-60,

"[I]f a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider this the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it."

Thus, the combination of elements from non-analogous sources in a manner that reconstructs the Applicant's invention only with the benefit of hindsight is insufficient to present a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d at 1447. Applicant contends that the inventions of Visinoni et al. is non-analogous art with Fanta et al.

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Visinoni et al. teaches a method of histological processing of tissue samples. However, the CO₂ used in that method is not in a supercritical condition as was described in the application as filed (p.9l. 21-P. 10l. 2). According to Visinoni et al. the clearing agent is applied at a pressure of up to 10 bar and at a temperature between room temperature and 90°C. These ranges exclude the possible use of a (near) supercritical fluid as a clearing agent. In contrast, Visinoni et al. only discloses toxic and volatile hydrocarbons such as xylene, limonene and n-hexane as suitable clearing agents (col. 3 l. 36 – col. 41. 3).

Fanta et al. would teach a method for removing ethanol from a sample, comprising the use of supercritical CO₂, let alone the dehydration of histological samples and/or replacing a supercritical fluid with an embedding medium. Since histological samples do not contain starch or a starch coating, it is highly unlikely that Fanta et al. would guide a skilled person to use supercritical CO₂ for dehydrating the samples in the method of Visinoni et al.

Thus, neither Visinoni et al. nor Fanta et al. alone or in combination with each other provides an incentive to use a supercritical fluid for dehydrating histological samples. A skilled person would therefore not arrive at the invention.

As a result, it can be seen that Visinoni et al., being concerned with the processing of organic tissues to prepare them for investigation by microscopy, has a completely different purpose from that of Fanta et al. which is concerned with isolating starch cells from ethanolic dispersion for further analysis. As a result, Fanta et al. and Visinoni et al. are not analogous art, and may not be combined to render the subject invention obvious.

Applicant hereby requests reconsideration and reexamination thereof.

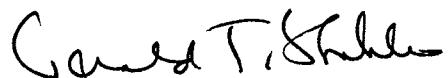
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No further fee or petition is believed to be necessary. However, should any further fee be needed, please charge our Deposit Account No. 23-0920, and deem this paper to be the required petition.

With the above amendments and remarks, this application is considered ready for allowance and applicant earnestly solicits an early notice of same. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he/she is respectfully requested to call the undersigned at the below listed number.

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Respectfully submitted,



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